

REMARKS

Claims 1-12, 23 and 24 are pending. Claims 13-22 have been cancelled without prejudice or disclaimer. However, Applicants expressly reserve the right to file one or more continuing applications containing claims reciting subject matter presented by one or more of the cancelled claims.

As the Amendment After Final Rejection of April 9, 2004 has not been entered, Applicants have included each of the amendments made therein into the present Amendment. Thus, the Amendment After Final need not be entered.

I. Claim Amendments

Claims 1 and 8 have been amended to recite that the compound "further comprises a carboxyl group." Support for this feature can be found in the present specification at page 7, line 4.

Additionally, claims 1 and 8 have been amended to clarify that the compound forms the film on the surface of the negative electrode after decomposing when the battery is charged, as supported in the paragraph bridging pages 1 and 2, as well as the paragraph bridging pages 6 and 7 of the present specification.

Support for new claims 23 and 24 can be found in the present specification at page 6, lines 22-23.

II. Claim Objections

Claims 14 and 15-22 stand objected to for various issues. However, as these claims have been cancelled without prejudice or disclaimer, Applicants respectfully submit that these objections are now moot.

III. 35 USC § 112

The Advisory Action remarks that the "non-aqueous electrolyte is 'a liquid' and therefore cannot comprise 'a compound that forms a film on a surface of the negative electrode.'" Claims 1 and 8 stand further rejected under 35 USC § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim that which is considered the invention. The Office Action notes that the claims are unclear, as the claims do not specify if the compound of Formula I is also in the form of a liquid. In particular, the Final Office Action, at page 3, lines 4-9 assumes that the compound of formula (1) is a solid film.

Applicants respectfully submit that the particular phase of the compound of formula (1) is not recited by the claims. While the claims certainly encompass electrolytes wherein the compound is a solid, the scope of the claims additionally includes electrolytes wherein the compound is, for example, a liquid. Although the specification describes that the electrolyte forms a film on the surface of the negative electrode, there is no reason why such a film could not be a liquid film. A film is defined by Merriam-Webster's Online Dictionary as "a thin covering or coating," and as such, a film need not be a solid structure. (See <http://www.merriamwebster.com/cgi-bin/dictionary?book=Dictionary&va=film>.)

IV. 35 USC § 102

A. JP '757

Claims 1, 4-8 and 11-22 stand rejected under 35 USC § 102(b) as allegedly being anticipated by JP 07-192757. However, as claims 13-22 are no longer pending, Applicants respectfully

submit that this rejection only applies to pending claims 1 and 4-8.

Applicants additionally submit that JP '757 fails to teach or suggest the subject matter of the claims as amended. Specifically, as detailed above, independent claims 1 and 8 (from which claims 4-7 depend) presently recite that the compound of the electrolyte comprises a carboxyl group. However, none of the compounds of the non-aqueous electrolyte of JP '757 contain a carboxyl group. Thus, JP '757 cannot expressly anticipate any of claims 1 and 4-8.

B. JP '765

Claims 1-22 stand rejected under 35 USC § 102(a) as allegedly being anticipated by JP 2000-348765, having a publication date of December 15, 2000. (However, as claims 13-22 are no longer pending, Applicants respectfully submit that this rejection only applies to pending claims 1-12.)

As the rejected claims are fully supported by the priority document, i.e., JP 2000-162008 (filed on May 31, 2000, i.e., prior to the publication date of JP '765), Applicants again respectfully submit that JP '765 is not a proper reference against these claims. An English-language translation was previously provided as an attachment to the Amendment After Final Rejection.

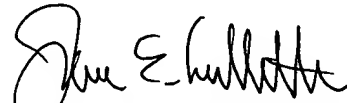
V. Conclusion

In view of the above, Applicants respectfully request entry of the above amendments and passage of the application to allowance. If any additional fee is necessary to make this amendment complete and/or timely filed, it may be charged to the

undersigned's deposit account number 19-4375.

If any issues remain which may best be resolved through a telephone communication, the Examiner is requested to telephone the undersigned at the local Washington, D.C. telephone number listed below.

Respectfully submitted,



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